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10/054,261	01/21/2002	Mark D. Latunski	5898-000190	7054

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EXAMINER
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SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,261

Applicant(s)

LATUNSKI ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-109 and 111 is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-15, 17-19, 21, 23-27, 31, 34 and 110 is/are rejected.
- 7) ☒ Claim(s) 9-12, 16, 20, 22, 28-30, 32, 33 and 35-38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1/21/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### **Double Patenting**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 8 of U.S. Patent No. 6,140,392 (Kingman et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Kingman et al. disclose lithographic ink comprising continuous phase comprising acid-functional vinyl resin and polyol phase comprising liquid polyol wherein the polyol phase is present in amount of 5-50%, 10-35%, or 20-30% and comprises weak acid or base.

The only difference between Kingman et al. and the present invention is that lithographic ink of the present invention comprises hydrogen bonding vinyl polymer while Kingman et al. disclose the use of acid-functional vinyl resin.

Applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to col.3, lines 8-10 and example 1 of Kingman et al. where it is disclosed that the acid-functional vinyl resin is a vinyl resin obtained from monomers including acid-functional monomer such as carboxylic acid including (meth)acrylic acid. It would have been within the skill level of, as well as obvious to, one of ordinary skill in the art that carboxylic acid is specific type of hydrogen bonding group.

Thus, it would have been obvious to one of ordinary skill in the art that acid-functional vinyl resin disclosed by Kingman et al. is one specific type of hydrogen bonding vinyl polymer presently claimed, and thus, one would arrive at the present invention from Kingman et al.

It is noted that evidence to support examiner's position is found in example 1 of the present specification, which discloses hydrogen bonding vinyl resin with carboxyl groups that is identical to the acid-functional vinyl resin disclosed in example 1 of Kingman et al.

3. Claims 1-6 and 8 are directed to an invention not patentably distinct from claims 1-6 and 8 of commonly assigned U.S. 6,140,392 (Kingman et al.). Specifically, although the conflicting claims are not identical they are not patentably distinct for the reasons set forth in paragraph 2 above.

4. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned U.S. 6,140,392 (Kingman et al.), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly

assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-6, 15, 17-19, 21, 23-27, 31, 34, and 110 are rejected under 35 U.S.C. 102(b) as being anticipated by Krishnan et al. (U.S. 5,778,789).

Krishnan et al. disclose lithographic ink comprising 25-60% water, 0-5% polymer such as polyvinyl alcohol, polyvinyl pyrrolidone, or polyacrylamide, 10-70% methacrylic resin or polystyrene sulfonic acid, 0-20% polymer obtained from (meth)acrylic ester, and 2% weak acid or base. Based on the above polymers, it is seen that Krishnan et al. disclose the use of hydrogen bonding vinyl polymers comprising hydrogen bonding groups including carboxylic acid, primary amide, ester group, and sulfur-containing group. there is also disclosed a method of printing the ink using lithographic printing process (col.3, line 26-col.4, line 18 and col.4, lines 34-36).

In light of the above, it is clear that Krishnan et al. anticipate the present claims.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. (U.S. 5,778,789) in view of JP 08108662.

The disclosure with respect to Krishnan et al. in paragraph 6 above is incorporated here by reference.

The difference between Krishnan et al. and the present claimed invention is the requirement in the claims of (a) citric acid or tartaric acid and (b) salt.

With respect to difference (a), pending translation of JP 08108662, and using machine translation of the Japanese reference, it is noted that JP 08108662, which is drawn to lithographic ink, discloses the use of citric acid or tartaric acid in order to control the pH of the ink (paragraph 7).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use of citric acid or tartaric acid in the ink of Krishnan et al. in order to produce lithographic ink with suitable pH, and thereby arrive at the claimed invention.

With respect to difference (b), pending translation of JP 08108662, and using machine translation of the Japanese reference, it is noted that JP 08108662, which is drawn to lithographic ink, discloses the use of alkali metal salt of nitric, boric, phosphoric, or sulfuric acid in order that the ink can be easily removed from the printing plate (paragraph 11).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use salt in the ink of Krishnan et al. in order to produce lithographic ink that is easily removable from the printing plate, and thereby arrive at the claimed invention.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. (U.S. 5,778,789) in view of Britton, Jr. (U.S. 5,024,700).



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The disclosure with respect to Krishnan et al. in paragraph 6 above is incorporated here by reference.

The difference between Krishnan et al. and the present claimed invention is the requirement in the claim of triethanolamine.

Britton, Jr., which is drawn to ink composition, disclose the use of triethanolamine in order to impart rheological properties to the ink and improve rub resistance (col.2, lines 31-41).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use triethanolamine in the ink of Krishnan et al. in order to produce ink with good rub resistance and suitable rheological properties, and thereby arrive at the claimed invention.

**Allowable Subject Matter**

11. Claims 39-109 and 111 are allowable over the "closest" prior art for the following reasons.

Krishnan et al. (U.S. 5,778,789) disclose lithographic ink comprising water, 0-5% polymer such as polyvinyl alcohol, polyvinyl pyrrolidone, or polyacrylamide, 10-70% methacrylic resin or polystyrene sulfonic acid, 0-20% polymer obtained from (meth)acrylic ester, and 2% weak acid or base. However, there is no disclosure or suggestion of branched hydrogen vinyl polymer as required in claim 39, no disclosure or suggestion of the Hansen solubility parameter, dispersion parameter value, polarity parameter value, and hydrogen bonding parameter value of the emulsified phase as required in claim 91, and no disclosure or suggestion of hydrogen bonding vinyl polymer with polydispersity of at least about 15 as required in present

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claim 93. Further, there is no disclosure or suggestion in Krishnan et al. of method of making a lithographic printing ink as required in present claim 107.

12. Claims 9-12, 16, 20, 22, 28-30, 32-33, and 35-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The above claims would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims for the following reasons.

Krishnan et al. (U.S. 5,778,789) disclose lithographic ink comprising water, 0-5% polymer such as polyvinyl alcohol, polyvinyl pyrrolidone, or polyacrylamide, 10-70% methacrylic resin or polystyrene sulfonic acid, 0-20% polymer obtained from (meth)acrylic ester, and 2% weak acid or base. However, there is no disclosure or suggestion that the lithographic ink comprise polyol phase, magnesium nitrate, hydrogen bonding vinyl polymer comprising amine, acetoacetate, hydroxyl groups, or hydrogen donating groups or hydrogen bonding vinyl polymer comprising combination of different hydrogen bonding groups as required in claims 9-12, 16, 20, 22, 28-30, 32-33, and 38. Further, there is no disclosure or suggestion of the equivalent weight in grams per equivalent of the hydrogen bonding vinyl polymer as required in claims 35-37.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van Damme et al. (U.S. 6,596,464) disclose single fluid lithographic ink comprising continuous phase containing acid-functional vinyl resin including branched vinyl resin and

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polyol phase. However, given the effective filing date of the reference, it is not applicable against the present claims under any subsection of 35 USC 102.

GB 2113701 discloses comprising single fluid lithographic ink composition wherein the ink comprises continuous phase that contains resin as well as a nonaqueous polyhydric alcohol, i.e. polyol, phase. However, there is no disclosure of hydrogen bonding vinyl polymer as presently claimed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
8/28/03